

## **REMARKS**

### **Status of Prosecution**

Applicant filed the original application on July 20, 2001. The Examiner mailed a first, nonfinal office action pertaining to restrictions on August 2, 2002 (Paper No. 4). Applicant filed a Reply to Paper No. 4 on August 26, 2002 (Paper No. 5). The Examiner mailed a first substantive, nonfinal office action ("Office Action 02" or "Office Action") on December 5, 2002 (Paper No. 6). This paper is in reply to that office action.

As a result, claims 1-30 are pending. Claims 24-30 are withdrawn from consideration. Claims 1-23 are under examination.

Applicant respectfully requests reconsideration and withdrawal of the rejections and objections raised in the Office Action, and allowance of claims as provided in this Reply.

### **Restriction Requirement**

Applicant is appreciative of the Examiner's determination that the arguments presented by Applicant in Paper No. 5, in reply to Paper No. 4 from the Examiner, were deemed persuasive, and that claims 1-23 are being examined in this case.

### **In the Drawings**

Please correct drawing Figures 4, 6, 8 and 10 as shown in the accompanying proposed drawing corrections filed as provided in 37 C.F.R. §1.121. As provided in 37 C.F.R. §1.85 and MPEP §608.02(b), the informal corrected drawing Figures will be replaced by formal drawings after issuance of a Notice of Allowance.

On page 2 of the Office Action, the Examiner stated that reference numbers "60" and "70" appear to be referring to the same element. Actually, reference numeral "60" refers to the base (see Application, page 9, ll. 21), whereas "70" refers to the more global reference of a means for variably positioning one or more clamps 34 in channel 16 of at least one rail 12 (see Application, page 9, ll. 25-26). Applicant, therefore, respectfully requests withdrawal of that portion of the objections to drawing figures.

### **Examiner's General Objections and Rejections**

In Office Action 02, the Examiner rejected claims 1-3, 6, 7, 9, 10, 16, 17 and 19, and objected to claims 4, 5, 11-15, 18 and 20-23.

The Examiner indicated that although the Examiner also objected to claims 4, 5, 11-15,

18 and 20-23, they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and that claims 16 and 19 would be allowable if rewritten to overcome rejections under 35 U.S.C. §112/2 and to include all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's indication of allowance, but believes Applicant is entitled to a broader scope of coverage.

On pages 2-3 of the Office Action, the Examiner objected to drawing informalities. In Reply, Applicant has included three sheets showing corrected drawing figures to be made formal on issuance of a Notice of Allowance.

On page 3 of the Office Action, the Examiner objected to specification informalities.

*First*, Applicant replies that reference numeral "10" is used consistently in the Application. In response, Applicant notes that reference numeral "10" is not used for the term "surface," as is confirmed from a review of the following extract from page 8 of the Application:

Referring initially to Figure 1, the system for removably and adjustably mounting a device on a surface is shown and generally designated 10. The system for removably and adjustably mounting a device on a surface 10, according to the present invention, includes....

Applicant suggests that on a first reading the second appearance of "surface" on page 8, ll. 13 of the Application seems to stand by itself because the words carry over from the preceding line.

*Second*, the Examiner objected to use of alphabetical subsets to reference numerals in the specification. For example, on page 8, ll. 16, Applicant used reference numeral "14a,b." The Examiner requested an amendment to "14a, 14b." Countless practitioners, however, have used the format used in the Application without objection in countless patent applications, for numerous years. After studying in detail both MPEP §608 and 37 CFR 1.81, Applicant's attorney found no requirement favoring either convention, and therefore concludes that in the interests of not appending to this Reply numerous specification amendments, both clean and amended, as now required by 37 C.F.R. §1.121, the conventions used in the Application should be acceptable.

*Third*, the Examiner correctly noted on page 4 that references to "a leading surface" and "a following surface" in claim 21 are not mentioned in the specification. Accordingly, Applicant deleted those references.

On page 4 of the Office Action, the Examiner rejected dependent claims 16 and 19 under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In reply, Applicant amended claims 16 and 19 to correctly identify the antecedent claim from which claims 16 and 19 depend, to clarify readability of the claims, and to more clearly particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Although Applicant believes that the amended language of claims 16 and 19 clearly defines the present invention, should the Examiner have any other proposed claim language, Applicant would certainly welcome such suggestions.

On pages 4-5 of the Office Action, the Examiner rejected claims 1-3, 6, 7, 9, 10 and 17 under 35 U.S.C. §102(b), stating that those claims are anticipated by U.S. Patent No. 5,571,338 issued November 5, 1996 to Kadonome, *et al.* ("Kadonome Patent"), an argument that Applicant respectfully traverses.

On page 5 of the Office Action, the Examiner rejected claim 10 under 35 U.S.C. §102(b), stating that those claims are anticipated by U.S. Patent No. 4,336,413 issued June 22, 1982 to Tourneux ("Tourneux Patent"), an argument that Applicant respectfully traverses.

Applicant respectfully urges, therefore, that the objections and rejections of the Examiner be withdrawn.

#### **First Rejection Under 35 U.S.C. §102(b)**

On pages 4-5 of the Office Action, the Examiner rejected claims 1-3, 6, 7, 9, 10 and 17 under 35 U.S.C. §102(b), stating that those claims are anticipated by U.S. Patent No. 5,571,338 issued November 5, 1996 to Kadonome, *et al.* ("Kadonome Patent"), an argument that Applicant respectfully traverses.

Applicant submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale in this country, more than one year prior to the date of filing of the present application in the United States.

Applicant's invention, in the claims under consideration, is directed to apparatus that include structural elements not included in the Kadonome Patent, and structural elements that cooperate differently than those claimed in the Kadonome Patent. Specifically, the dual track

rail of Applicant's invention is not claimed or suggested in the Kadonome Patent. As stated in the Application, page 5, ll. 23-25, the unique dual track rail of the present invention, in combination with the novel clamps of the present invention, permits slidable adjustment and readjustment of the location on a rail on which a module may be positioned.

Each track in the dual track configuration of the present invention includes a channel extending the length of the rail. A slot also extending the length of the rail is formed in each channel. The slots are arranged at approximately a right angle to each other. The unique channel construction helps achieve the advantages of the present invention by making the rail adjustable to a wide variety of modules. See Application, page 6, ll. 1-15, and Figures 3 and 4. Indeed, as indicated in the Application, the present invention has universal application to substantially all installations of modules. See Application, page 3, ll. 25-29 and carry-over to page 4, ll. 1-14, which also explains the use of the present invention both in "top down" and "bottom up" mounting modes.

The Kadonome Patent however, is limited to use in connection with essentially a single form of module. That limitation derives from the "upwardly open groove(s)" 32d of the "exterior frame structure" 32 of the module as shown in Figures 8 and 9 of the Kadonome Patent. The sides defining the upwardly open grooves of the Kadonome Patent are perhaps best shown by cross-reference to Fig. 18, reference numerals 132 and 132c. According to the specification of the Kadonome Patent, "the photovoltaic apparatus...includes an exterior frame structure having upwardly opening channels...[to] prevent rain water from leaking between the panels...." See Kadonome Patent, col. 3, ll. 51-57. That limitation is deemed significant to the inventors of the Kadonome Patent because the upwardly open groove limitation is claimed in independent claim 1. See Kadonome Patent, col. 9, ll. 11-18. The apparatus for mounting the photovoltaic module also includes the same structural limitation in independent claim 3. See Kadonome Patent, col. 9, ll. 21-45 ("...at least one lengthwise member...having a top open groove....").

No such limitations are found in the Application being examined.

For those structural reasons, and for the reasons articulated below under "Discussions of Rejections under §102," Applicant respectfully requests that the rejection be withdrawn.

#### **Second Rejection Under 35 U.S.C. §102(b)**

On page 5 of the Office Action, the Examiner rejected claim 10 under 35 U.S.C. §102(b),

stating that those claims are anticipated by U.S. Patent No. 4,336,413 issued June 22, 1982 to Tourneux ("Tourneux Patent"), an argument that Applicant respectfully traverses.

That reference, however, discloses a photovoltaic panel that is mounted directly on the surface of a roof. See Abstract of the Tourneux Patent ("The [photovoltaic] panel is equipped with a peripheral frame.") The Tourneux Patent provides no structural support for holding or securing a module or surface; the panel frame itself is the mounting structure. See Tourneux Patent, col. 7, ll. 11-37 through carry-over to col. 8, ll. 1-8.

The Examiner states that the Tourneux Patent includes "one or more clamps (70) variably positionable on the dual track and footing grid for demountably securing the module to the footing grid..." See Office Action, page 5, last two lines. Applicant respectfully disagrees. The Tourneux Patent states that "Fig. 7 indicates by a schematical sectional view a method of fastening of the panel according to the invention by nail or screw crossing the extra wing 70 of piece 61...The panel then rests on its top edge on the batten 72 to which it is fastened." See col. 5, ll. 29-35. Accordingly, there is no clamp; the fastener does not allow for variably positioning; and the fastener does not result in demountably securing the module to a footing grid.

Indeed, the Tourneux Patent shows a method of operation different than that of the present invention. A person skilled in the art would not know from reviewing the reference that any element of the invention in the Tourneux Patent could be variably positioned. Applicant respectfully directs the Examiner's attention to the last paragraph of MPEP §2143.01, the heading of which states that "The Proposed Modification Cannot change the Principle of Operation of a Reference."

For those structural reasons, and for the reasons articulated below under "Discussions of Rejections under §102," Applicant respectfully requests that the rejection be withdrawn.

#### **Discussion of Rejections under 35 U.S.C. §102**

For fundamental teaching on the doctrine of anticipation, one must consider the decision of Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard. *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1457, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Our review of a finding of anticipation is the same whether it was made by the board or by a district court.

*In re William J. King* at 231 USPQ 139 (emphasis added).

Further, for a reference to anticipate a claim under 35 U.S.C. §102, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). “Anticipation” is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. The test for infringement by anticipation should be rephrased as, “That which would *literally* infringe if later in time anticipates if earlier than the date of invention.” (Emphasis in the original) See also *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987). Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), “there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (Emphasis added.) As discussed above, the Reference does not disclose the identical structure and cooperation of structure as described in the Application examined by the Examiner. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Therefore, Applicant respectfully urges that neither of the cited references anticipates Applicant's invention as now claimed, and that the rejections under 35 U.S.C. §102(b) be withdrawn.

### **Conclusions**

For the reasons set forth above reconsideration and withdrawal of the rejection of claims 1-23 is respectfully requested.

The remaining references cited by the Examiner, but not relied on for the rejection of claims 1-23, have been noted. Because the remaining references are no more pertinent than the applied references, a detailed discussion of these remaining references is deemed unnecessary for a full and complete Reply to the Office Action.

In conclusion, Applicant respectfully asserts that this Reply is complete as contemplated in 37 C.F.R. § 1.111, that claims 1-23 and 31-37 are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant respectfully

requests an early notice of allowance. The Examiner is requested to call the undersigned at (505) 897-7200 for any reason that would advance the instant application to issue.

Respectfully submitted,

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